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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,336	02/13/2006	Mikio Fukuda	SAIT4480	3346
5409 7590 10/22/2007 SCHMEISER, OLSEN & WATTS 22 CENTURY HILL DRIVE SUITE 302 LATHAM, NY 12110			EXAMINER GUZMAN, APRIL S	
			ART UNIT 2618	PAPER NUMBER
			MAIL DATE 10/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,336

Applicant(s)

FUKUDA, MIKIO

Examiner

April S. Guzman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/13/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Examiner acknowledges the receipt of the Applicant's amendments filed on 07/30/2007. Claims 1-8, and 10-15 have been amended. Claims 1-15 are therefore still currently pending in the present application.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Applicant's admission of prior art** in view of **Lee et al. (WO 2004/032566 A1)**.

Consider **claim 1**, Applicant's admission of prior art teaches a portable telephone using a bone conduction device (read as bone conduction speaker 31) (page 1 [0002]) comprising:

a housing having a concave portion (read as housing 32 within a concave portion 33), which is larger in diameter than said bone conduction device, and wherein said housing forms a main body of the telephone (Figure 10, Figure 11, and page 1 [0002]);

a cushioning material (read as cushioning material 34) disposed between said concave portion of said housing and said bone conduction device (Figure 10, Figure 11, and page 1 [0002]);

a gap formed between said bone conduction device and said concave portion of said housing by said cushioning material (Figure 10, Figure 11, and page 1 [0002]).

However, Applicant's admission of prior art fail to teach a vibration surface of said bone conduction device positioning to be slightly extended outward from said housing by said cushioning material.

In the related art, Lee et al. teach a vibration surface (read as mastoid 18) of said bone conduction device positioning to be slightly extended outward from said housing by said cushioning material (Figure 1, Figure 2, page 10 lines 23-25, page 11 lines 1-5 and page 11 lines 12-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Lee et al. into the teachings of Applicant's admission of prior art for the purpose of providing a bone conduction speaker having a function

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of vibrational hearing together with a function of acoustic hearing and a mobile phone having the bone conduction speaker.

Consider **claim 2**, Applicant's admission of prior art teaches a portable telephone using a bone conduction device (read as bone conduction speaker 31) (page 1 [0002]) comprising:

a housing having a surface and a through-hole portion (read as housing 32 within a concave portion 33), wherein said through-hole portion is configured to be larger than said bone conduction device, wherein said housing forms a main body of the telephone (Figure 10, Figure 11, and page 1 [0002]);

a cushioning material (read as cushioning material 34) disposed between an inner surface of said through-hole portion and said bone conduction device (Figure 10, Figure 11, and page 1 [0002]).

However, Applicant's admission of prior art fail to teach a vibration surface of said bone conduction device extended outward from said housing by said cushioning material.

In the related art, Lee et al. teach a vibration surface (read as mastoid 18) of said bone conduction device extended outward from said housing by said cushioning material (Figure 1, Figure 2, page 10 lines 23-25, page 11 lines 1-5 and page 11 lines 12-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Lee et al. into the teachings of Applicant's admission of prior art for the purpose of providing a bone conduction speaker having a function of vibrational hearing together with a function of acoustic hearing and a mobile phone having the bone conduction speaker.

Consider **claim 3, as applied to claim 2 above**, Applicant's admission of prior art as modified by Lee et al. further teach wherein an opposite side of said bone conduction device also serve as a vibration surface (Lee et al. – Figure 1, Figure 5, page 10 lines 23-25, page 11 lines 1-5, page 11 lines 9-17; Kim et al. – page 9 lines 3-13).

Consider **claim 4, as applied to claim 1 above**, Applicant's admission of prior art as modified by Lee et al. further teach wherein the portable telephone is a foldable type provided with a housing constructed of two housing portions foldable relative to each other (Lee et al. – Figure 4, and page 18 lines 5-18); and

a folded position of the telephone, wherein a vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions (Lee et al. – Figure 4, and page 18 lines 5-18).

Consider **claim 5, as applied to claim 1 above**, Applicant's admission of prior art as modified by Lee et al. teach wherein the portable telephone and a vibration surface.

However, Applicant's admission of prior art as modified by Lee et al. fail to teach the portable telephone is a rotatable type provided with a housing constructed of two housing portions rotatable relative to each other; and

the vibration surface of said bone conduction device that abuts an inner surface of one of said two housing portions when the two housing portions are rotated closed.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone could be a rotatable type.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the portable telephone as a rotatable type portable telephone for

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the purpose of the bone conductor device to be used in an alternate type of portable telephone with a different housing construction but with the same functionality and same results.

Consider **claim 6, as applied to claim 1 above**, Applicant's admission of prior art as modified by Lee et al. teach wherein the portable telephone and a vibration surface.

However, Applicant's admission of prior art as modified by Lee et al. fail to teach the portable telephone is a slidable type provided with a housing having two housing portions that are slidable relative to each other when the telephone is in a closed position; and when in the closed position of the telephone, the vibration surface of said bone conduction device abuts an inner surface of one of said housing portions, which is disposed oppositely from said other housing portions, wherein said other housing portions carries said bone conduction device of said housing.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone could be a slidable type.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the portable telephone as a slidable type portable telephone for the purpose of the bone conductor device to be used in an alternate type of portable telephone with a different housing construction but with the same functionality and same results.

Consider **claim 7**, Applicant's admission of prior art teach a portable telephone using a bone conduction device (read as bone conduction speaker 31) (page 1 [0002]) comprising:

a housing having a device installation opening (read as housing 32 within a concave portion 33) (Figure 10, Figure 11, and page 1 [0002]); and

a device holder is constructed of a container portion and a fixing portion (Figure 10, Figure 11, and page 1 [0002]-[0004]).

However, Applicant's admission of prior art fail to teach the device holder made of resilient material, wherein said container portion carries said bone conduction device therein, and wherein said fixing portion is fixed mounted on an inner surface of said device installation opening of said housing of the telephone.

In the related art, Lee et al. teach the device holder made of resilient material, wherein said container portion carries said bone conduction device therein, and wherein said fixing portion is fixed mounted on an inner surface of said device installation opening of said housing of the telephone (Figure 4, page 18 lines 5-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Lee et al. into the teachings of Applicant's admission of prior art for the purpose of providing a bone conduction speaker having a function of vibrational hearing together with a function of acoustic hearing and a mobile phone having the bone conduction speaker.

Consider **claim 8, as applied to claim 7 above**, Applicant's admission of prior art as modified by Lee et al. further teach wherein an abutting plate is fixedly mounted on said bone conduction device to cover a front surface side of said container portion, wherein said plate is so arranged as to slightly extend outward from said housing (Lee et al. – Figure 1, Figure 5, page 10 lines 11-25, and page 11 lines 1-17).

Consider **claim 9, as applied to claim 8 above**, Applicant's admission of prior art as modified by Lee et al. further teach wherein a circular rib for receiving therein a peripheral edge

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portion of a rear surface of said abutting plate is provided in a front surface side of said container portion (Lee et al. – Figure 1, Figure 2, page 10 lines 11-25, and page 11, lines 1-5).

Consider **claim 10, as applied to claim 1 above**, Applicant's admission of prior art as modified by Lee et al. teach the portable telephone.

However, Applicant's admission of prior art fail to teach wherein the portable telephone is a rotatable type provided with a housing constructed of two housing portions rotatable relative to each other, when in a closed position the telephone said vibration surface of said bone conduction device abuts one of said two housing portions;

an inner surface of one of said two housing portions oppositely disposed from the other one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone could be a rotatable type.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the portable telephone as a rotatable type portable telephone for the purpose of the bone conductor device to be used in an alternate type of portable telephone with a different housing construction but with the same functionality and same results.

Consider **claim 11, as applied to claim 2 above**, Applicant's admission of prior art as modified by Lee et al. teach the portable telephone.

However, Applicant's admission of prior art fail to teach wherein the portable telephone is a rotatable type provided with a housing constructed of two housing portions rotatable relative to each other; and

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a closed position of the telephone, wherein said vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone could be a rotatable type.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the portable telephone as a rotatable type portable telephone for the purpose of the bone conductor device to be used in an alternate type of portable telephone with a different housing construction but with the same functionality and same results.

Consider **claim 12, as applied to claim 3 above**, Applicant's admission of prior art as modified by Lee et al. teach the portable telephone.

However, Applicant's admission of prior art fail to teach wherein the portable telephone is a rotatable type provided with a housing constructed of two housing portions rotatable relative to each other; and

a closed position of the telephone, wherein said vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone could be a rotatable type.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the portable telephone as a rotatable type portable telephone for the purpose of the bone conductor device to be used in an alternate type of portable telephone with a different housing construction but with the same functionality and same results.

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Consider **claim 13, as applied to claim 1 above**, Applicant's admission of prior art as modified by Lee et al. teach wherein the portable telephone.

However, Applicant's admission of prior art fail to teach wherein the portable telephone is of a slidable type provided with a housing constructed of two housing portions slidable relative to each other; and

a closed position of the telephone, wherein said vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone could be a slidable type.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the portable telephone as a slidable type portable telephone for the purpose of the bone conductor device to be used in an alternate type of portable telephone with a different housing construction but with the same functionality and same results.

Consider **claim 14, as applied to claim 2 above**, Applicant's admission of prior art as modified by Lee et al. teach wherein the portable telephone.

However, Applicant's admission of prior art fail to teach wherein the portable telephone is a slidable type provided with a housing constructed of two housing portions slidable relative to each other; and

a closed position of the telephone, wherein said vibration surface of said bone conduction device abuts on an inner surface of one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone could be a slidable type.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the portable telephone as a slidable type portable telephone for the purpose of the bone conductor device to be used in an alternate type of portable telephone with a different housing construction but with the same functionality and same results.

Consider **claim 15, as applied to claim 3 above**, Applicant's admission of prior art as modified by Lee et al. teach wherein the portable telephone.

However, Applicant's admission to prior art fail to teach wherein the portable telephone is a slidable type provided with a housing constructed of two housing portions slidable relative to each other; and

a closed position of the telephone, wherein said vibration surface of said bone conduction device abuts on an inner surface of one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone could be a slidable type.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the portable telephone as a slidable type portable telephone for the purpose of the bone conductor device to be used in an alternate type of portable telephone with a different housing construction but with the same functionality and same results.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: see PTO-892 Notice of Reference Cited.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

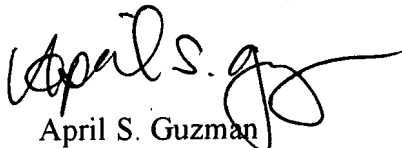
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to April S. Guzman whose telephone number is 571-270-1101. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lana Le can be reached on 571-272-7891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


April S. Guzman
A.S.G/asg

10/09/07


10-12-07
LANA LE
PRIMARY EXAMINER